

Application No. 09/713,780
Amendment dated February 7, 2004
Reply to Office Action of July 16, 2003

REMARKS

Applicants respectfully request entry of the amendment and reconsideration of the claims. Claims 1-3 and 17-24 have been canceled. Claims 4, 9, and 25-29 have been amended to further clarify the invention. Claims 30-36 are newly presented. After entry of the amendment, claims 4, 5, 9, 10, 25-29, and 30-36 are pending.

Applicants submit the amended claims are supported throughout the specification, including at least at page 9, lines 3-24. Applicants submit the newly presented claims are supported throughout the specification, including at least at page 3, lines 14-18 and page 16, lines 1-7 and lines 23-24. Neither the claim amendments nor newly presented claims raise any issues of new matter.

Applicants note the amendment to claim 4 does not extend beyond subject matter elected in the Restriction Requirement and is therefore proper.

With respect to the Notice of Non-compliant amendment mailed on January 28, 2004, Applicant notes that claim 9 was amended in the version faxed on November 13, 2003. However, in this version, claim 9 has been amended in the alternative format provided for in the "REVISED AMENDMENT PRACTICE: 37 CFR 1.121... ", when fewer than five characters are deleted.

Novelty

The Examiner rejected claims 14-, 9, 10, and 28 under 35 U.S.C. § 102(b) as being anticipated by Cruz (U.S. Patent No. 5,871,779). Applicants respectfully traverse the rejection.

To anticipate a claim, each and every element of the claim must be described, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil*, 814 F.2d 628, 631 (Fed. Cir. 1987). Applicants have directed the claims to vanadium compounds wherein R₃ and R₄ are each independently a cyclopentadienyl ring. Cruz does not teach a cyclopentadienyl ring at positions R₃ and R₄. Therefore, Cruz does not describe each and every element of Applicants' claims. Withdrawal of the rejection is respectfully requested.

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Obviousness

The Examiner rejected claims 25-27 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Cruz in view of Billington et al. (U.S. Patent No. 5,648,382). Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. MPEP § 2142. Three criteria must be met by the Examiner to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). The Examiner has failed, in the least, to establish that the cited references teach or suggest all of the claim limitations.

As discussed above, the primary reference Cruz does not teach a cyclopentadienyl ring at positions R₃ and R₄. Billington et al. does not remedy the shortcomings of the primary reference. Billington et al. does not teach or suggest a vanadium compound wherein R₃ and R₄ are each independently a cyclopentadienyl ring. Therefore, there is no suggestion to combine these references. Even if there were, the combination of references does not teach or suggest all of the claim limitations.

Based on the forgoing, Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness. There is no suggestion or motivation to combine the references as required. Even if the suggestion were made, the cited references fail to teach or suggest the invention as claimed. Withdrawal of the rejection is respectfully requested.

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Summary

In view of the above amendments and remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

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